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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,243	06/22/1999	SCOTT D. MAURER	30349	8744

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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 05/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/337,243

Applicant(s)
Maurer

Examiner
Michael Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2001 & Dec 13, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 14-19, 23, 26-39, and 41-50 is/are pending in the application.
- 4a) Of the above, claim(s) 16-19 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 14, 15, 26-39, and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other: _____

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In view of the preliminary amendment filed December 13, 2001 the previous Office action of January 02, 2002 is hereby vacated. Below find an Office action on the merits taking into consideration the preliminary amendment filed December 13, 2001.

Information Disclosure Statement

1. The information disclosure statement filed December 13, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Applicant has failed to provide a date of publication for the reference "Outwater Plastics Industries" listed under 'Other Documents'. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 C(1).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-8, 14, 15, 26-39, and 41-50 are rejected under 35 U.S.C. 112, first paragraph, as

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containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not appear to have specifically presented the variously recited differing genus groupings presented within each of claims 6, 7, 8, 39 and 42. Nor had the disclosure originally presented a foam member rollable into a coil having a radius of curvature ranging from about 2 inches to about 15 inches, nor a radius of curvature less than 12 inches, nor a radius of curvature from about 6 inches to about 12 inches.

With respect to Applicant's remarks on page 3 of the amendment filed December 13, 2001, it is not clear as to how Applicant arrives at the specific calculations or ranges listed in the accompanying chart. In any event, no indication, whatsoever, had ever been afforded within the original disclosure as to any range or specific value of any radius of curvature. In other words, one of ordinary skill in the art would not be able to ascertain the exact range or specific value of any radius of any coil formed by the foam member of the instant disclosure. For example, radius of curvature would depend upon how much the foam member is compressed while in a coil or the radius would change depending on both the size of container to hold the foam member and the length of the foam member. It is, otherwise, not apparent as to how Applicant had arrived at the maximum radii of curvature listed for each of the presented lengths of foam members in a 30' x 30' box, thickness of foam member notwithstanding.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 42 appears to present a genus differing from that presented within claim 39 from which claim 42 depends. Therefore, it is unclear as to what form the side profile of the molding follows.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 2-5, 14, 26-32, 34-39, 41, 42,, and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson. Johnson shows a flexible polyvinyl plastic foam member 12/16/17 having pressure sensitive adhesive 19 affixed to a rear side thereof along a "top" portion and "bottom" portion with a release strip 20 covering the adhesive layer. Or, a single flexible polyvinyl

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plastic foam member 12 having pressure sensitive adhesive 18 affixed to a rear side thereof. A first surface of the rear surface is as at 15, particularly Fig. 3), with the first surface forming a corner with an intersecting surface, (i.e., that surface which leads into the first surface). The "first surface" would be on either side of groove 15. The Johnson molding possessing any decorative cross section, col. 4, lines 60-62. The flexible foam of Johnson being rollable along a length thereof into a coil having a radius of curvature ranging from about 2 inches to about 15 inches including a radius of curvature less than 12 inches as well as a radius of curvature from about 6 inches to about 12 inches.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson. To have formed the Johnson molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, as well as form the molding of a thickness between 3/16 and 3/4 inch, thus allowing for adequate protection and enhanced aesthetic appearance, would have constituted an obvious expedient to one of ordinary skill in the art. Forming the Johnson molding of a foam having a density of less than 9 lbs./cu. ft., thus

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providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art.

10. Claims 2-5, 14, 15, 26-39, 41, 42, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finefrock. Finefrock shows a flexible rubber or other elastomeric member 11 having pressure sensitive adhesive 16, 17 affixed to a rear side thereof with a release strip 19, 20 covering the adhesive layer. To have formed the Finefrock member 11 of a plastic foam rubber material such as a rubber latex or a polyethylene foam, thus affording the desired properties of Finefrock with a cost effective material, would have constituted an obvious expedient to one of ordinary skill in the art. Forming the Finefrock molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, as well as form the molding of a thickness between 3/16 and 3/4 inch, thus allowing for adequate protection and enhanced aesthetic appearance, would have constituted a further obvious expedient to one of ordinary skill in the art. Forming the Finefrock molding of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art. The resulting flexible foam of Finefrock being rollable along a length thereof into a coil having a radius of curvature ranging from about 2 inches to about 15 inches including a radius of curvature less than 12 inches as well as a radius of curvature from about 6 inches to about 12 inches.

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11. Claims 2-5, 14, 15, 26-39, 41, 42, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan '469 in view of either of Johnson or Finefrock. Logan '469 shows, Figs. 2, 4, and 6, a flexible plastic foam member 10 having pressure sensitive adhesive 20 affixed to a rear side thereof. Each of Johnson and Finefrock teach utilization of a release strip to cover an adhesive layer affixed to a rear surface of a molding strip. To have provided the Logan '469 molding with a release strip covering the adhesive layer 20 along a rear surface of the molding, thus providing protection for the adhesive strip prior to application along a wall, would have constituted an obvious expedient to one of ordinary skill in the art as taught by either of Johnson at 20 or Finefrock at 19, 20. To have formed the Logan member 10 of a plastic foam material such as a polyethylene foam, thus affording the desired properties of Logan with a cost effective material, would have constituted an obvious expedient to one of ordinary skill in the art. Forming the resulting Logan molding of a length greater than 30 feet, thus accommodating any particular stretch of corner to be decorated, as well as form the molding of a thickness between 3/16 and 3/4 inch, thus allowing for adequate protection and enhanced aesthetic appearance would have constituted a further obvious expedient to one of ordinary skill in the art. Forming the resulting Logan molding of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art. The resulting flexible foam of Logan '469 being rollable along a length thereof into a coil having a radius of curvature ranging from about 2 inches

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to about 15 inches including a radius of curvature less than 12 inches as well as a radius of curvature from about 6 inches to about 12 inches.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
May 9, 2002